



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/750,001

12/29/2000

Scott M. Frank

60027.5200USU1/ 00-428

6605

82866 7590 05/11/2009

AT&T Legal Department - HBH

Attn: Patent Docketing

One AT&T Way

Room 2A-207

Bedminster, NJ 07921

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/750,001	<b>Applicant(s)</b> FRANK ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 86-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Request for Continued Examination*

1. The Request filed on 4/27/2009 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750,001 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. Claims 1-85 and 104-109 have been cancelled; therefore Claims 86-103 are currently pending in application 09/750,001.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. **Claims 86-103 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter (US 6,298,327) in view of Eggleston et al. (US 6,061,660).**
6. As per **independent Claims 86, 92, and 98**, Hunter discloses a computer-readable medium containing a program for use with a computer (apparatus, method) for tracking innovations as part of a system for managing protection and licensing of intellectual property assets

Art Unit: 3629

(abstract, Fig.2, Fig.8), the program comprising: receiving intellectual property asset protection data (inventive disclosure, C2-C5), wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets owned by the organization, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception), wherein the intellectual property asset protection data further includes data related to a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators for the organization (system tracks multiple inventions from multiple inventors); determining participation data for each of a plurality of innovator classes (C3 L53-67, invention categorized with specific technology group); and storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (C2-C5, Fig.2, database).

7. While Hunter does disclose tracking innovations, inventors, and inventor related information (C11 L48-57, C18 Table 3), Hunter fails to expressly disclose receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of the

Art Unit: 3629

stocked disclosure gifts; tracking the disclosure gifts and gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances.

8. However, Eggleston discloses the creation of employee incentive programs, which include tracking/automated fulfillment of non-monetary reward distribution data (to employees for job related-activities) to include sponsor and award databases (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20, C45-C46). Furthermore, Eggleston discloses utilizing an awards tracking database and inventory replenishment technology (C39-40).
9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts; tracking the disclosure gifts and gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances, as disclosed by Eggleston in the system disclosed by Hunter, for the advantage of providing a method for tracking innovations with the ability to increase effectiveness of the system by offering/tracking all facets of innovations submission process, to include compensating/awarding the innovation submitter. (See KSR [127 S Ct. at 1739]

Art Unit: 3629

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

10. As per Claims 87, 93, and 99, Hunter discloses tracking and reporting costs associated with the purchase of disclosure gifts (C45-C46, sponsor and award database).
11. As per Claims 88, 94, and 100, Hunter discloses tracking and reporting information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators (C45 L27-50, consumer/participant database).
12. As per Claims 89, 95, and 101, Hunter discloses automatically totaling numbers of disclosure gifts distributed within a time period (C45-C46, sponsor and award database information/aggregation of information based on date).
13. As per Claims 90, 96, and 102, Hunter and Eggleston fail to expressly show wherein the plurality of innovator data, including employee/contractor status and a management /non-management status.
14. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator data stored. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a plurality of innovator data, to include: employee/contractor status and a management /non-management status, because such data

Art Unit: 3629

does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

16. As per Claims 91, 97, and 103, while Hunter does disclose storing organization data associated with the innovator (Para0109, type of originator), Hunter fails to expressly show the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.
17. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator descriptive data used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a innovator descriptive data (organization al date) to include: at least one of affiliate organization, company, division, and business unit, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Response to Arguments***

19. Applicant's arguments filed 4/27/2009 regarding Claims 86-103 have been considered, but are not persuasive. The rejection will remain as NON-FINAL based on the sited prior art.

Art Unit: 3629

20. Regarding the Applicant's arguments, the Applicant is directed to the revised/clarified rejection above.
21. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

May 11, 2009

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629